

## **REMARKS/ARGUMENTS**

Favorable reconsideration of this application, as presently amended, is respectfully requested.

Claims 27-38 were previously pending in the application. Claims 27, 28 and 36 have been cancelled without prejudice to refiling. Claims 39-44 are new. The amendments to the claims are intended to clarify and not to narrow the scope of the subject matter being claimed.

### **Rejection under 35 U.S.C. 112, second paragraph**

Applicants respectfully traverse this rejection on grounds that the examiner has failed to establish a *prima facie* rejection for indefiniteness. According to MPEP Section 2173.02,

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

It is submitted that the examiner has not made these inquiries, and that someone of ordinary skill in the art would understand how to avoid infringement, when considering the claims in context. See *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004) ("The requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles...Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite."). The same section of the MPEP further explains,

... if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant."

In order to expedite reconsideration, applicants have taken the examiner's rejections as suggestions for improved language and amended the claims to incorporate the examiner's suggestions where understood by applicant and where doing so would not narrow the scope of protection being sought.

#### Rejection of claims 29-35 under 35 U.S.C. 103

It is submitted that there are several errors in the reasoning supplied by the examiner in rejecting claims 29-35 on grounds that they define obvious subject matter in view of Amridge et al, either alone or in combination with Jensen.

According to a recent Board decision in *Ex parte Wada and Murphey*, Appeal 2007-3733 (BPAI January 14, 2008),

When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art." In re Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing In re Royka, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

First, it is submitted that the examiner has erred in his factual finding that member 24 possesses an indentation, as shown by Figure 7. Amridge et al. identify member 24 as a transparent "overlamine protectively layer" (col. 2, lines 16-17). However, contrary to the examiner's assertion, applicants cannot find evidence in either Figure 7 or the accompanying text that the sheet of translucent film constituting the overlamine protective layer 24 is indented. Merriam-Webster's Tenth Collegiate Dictionary defines "indentation" as meaning "1. A: an angular cut in an edge; NOTCH b: a recess in a surface 2: the action of indenting; ...." The common and ordinary meaning "recess in a surface" is consistent with the applicants' use of the term indentation in the specification, as the indentation is formed by debossing the member.

The thickness of the overlamine protective layer appears constant in the figure. There is no recess formed in any surface of the layer. Applicants submit that there is no basis to conclude, or evidence to support any belief, that the overlamine protective layer would be

indented when applied by a person to the label for protection. Indeed, it is submitted that, just like a table cloth being draped over a table, layer 24 of Ambridge et al. simply bends. Furthermore, even if it could be argued that there would have to be some indentation during application, it would be impossible for the depth of the recess in the overlamine protective layer 24 to be the same as the thickness of image sheet 20, as image sheet 20 is at least as thick as the layer. Both come from same label stock 14. See col. 2 at lines 8-10 (Label stock is divided into two portions, 20 and 24, by perforation line 18). They must have the same thickness. Indeed, as a additional opaque layer is added to the portion 20 during manufacture, the label is arguably thicker than the protective layer 24.

Third, it is submitted that the examiner has failed to articulate reasons with rational underpinnings necessary to support the legal conclusion of obviousness. See *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), ([R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”). See also MPEP §2141.

The examiner appears to concede that there are at least two differences between Ambridge et al. and the subject matter of claim 29. First, the image sheet is not, in fact, bonded to the member, but rather to a completely different substrate. Second, the image on the image sheet faces member. The examiner also states that Ambridge et al. also fails to disclose “that the substrate is a transparent sheet.” However, claim 29 does not require a separate “substrate.”

Assuming for a moment that the overlamine protective layer 24 has a recess in its surface, there would have to be a rearrangement of the parts and a change in the purposes for which the parts are used. The examiner explains that it would have been obvious to reverse the orientation of the image sheet 20, and to make the substrate to which it is attached transparent. “The end use of the device would dictate which side one would want to see the image, and clearly one could expect predictable results by merely reversing the orientation of the image sheet and making the substrate transparent,” the examiner reasons. However, this reasoning appears to be contrary to the teachings of the reference, and impermissibly relies on the benefit of hindsight.

In Ambridge et al, multiple label assemblies are releasably affixed to a liner 12. Portion 20 of the label assembly is peeled from a liner 12, and some desired “indicia” is printed on it by a handheld printer or other method. It is then applied to a “desired object,” using the adhesive 16 that is “permanently affixed to the underside of the label stock.” Portion 24, which is larger, is then applied over portion 20, with its edges extending over the portion 24. It adheres to both portion 24 and the object to which the label is applied. Ambridge et al. would therefore teach to a person of ordinary skill who wanted to manufacture an article with a graphic image only to apply the image to the article and overlay it with a protective cover that extends beyond the edges of the substrate onto which the image was printed.

The examiner’s proposed modifications appear to defeat the purpose and mode of operation for which the Ambridge et al. label assembly was designed. Turning the label upside down to face the object would appear to be counterproductive, even if the object was transparent. What is the point of applying a label upside down to the outer surface of an object? Additionally, there would be no way to stick the label to the object if the label was turned upside down, thus changing the mode of operation in yet another way. Because a special opaque layer must be applied to the label stock for receiving the printing, presumably there can be no printing on the side to which the adhesive is applied. The protective layer 24 does not and could not serve as a cover part of an article of the type listed in the claim. It is simply “label stock” – a thin film. These changes in operation of the reference’s structure, in contradiction to what the reference would plainly suggest to a person of ordinary skill, indicate that a person of ordinary skill would not find the differences to be so insubstantial as to make the claimed invention obvious. Some inventiveness would be required to go from Ambridge et al to the claimed subject matter.

Furthermore, the sole rationale for making the changes is applicant’s own teachings -- “the end use of the device.” There is no other reason given for making the modification. It is submitted that this is an impermissible use of hindsight.

The MPEP quoting the U.S. Supreme Court’s decision in *KSR* explains,

“When considering obviousness of a combination of known elements, the operative question is thus ‘whether the improvement is more than the predictable use of prior art elements according to their established functions.’”

MPEP §2141. It is submitted that even if the other errors are ignored and the references show all of the elements, the modifications have changed the established functions of these elements in the reference. Therefore, given the reliance of applicants' own teachings, it is submitted that the examiner has not provided the necessary rationale to support the conclusion of obviousness.

Second, the examiner appears to be ignoring the limitation in the claims that the "member" be part of a "cover part" for the claimed article. Portion 24 appears to protect only a label. It does not constitute a cover part of an article.

Third, it is submitted that Ambridge et al. concerns the art of "adhesive overlamine label assemblies," (see "Technical Field" section Ambridge et al.) and not the manufacture of portfolios, desk folders, ring binders, wallets and similar accessory articles. It is submitted that a person of ordinary skill in the art to which the invention pertains would not look to teachings involving labels sold on sheets for printing and application to objects that are already made. Therefore, they are not analogous arts.

Therefore, in view of these errors, applicants respectfully traverse the rejection of claim 29. As claims 30 to 34 depend from claim 29, their rejection is in error for at least the same reasons.

#### Rejection of claims 37 and 38 under 35 USC §102(b) or §103

The examiner contends that claims 37-38 are anticipated or obvious in view of Ambridge et al. or, in the alternative, US. Patent No. 3,153,868 of Jones.

Claims 37 and 38 have been amended to make clear that the image on the image sheet faces away from the member, and that the application of RF energy results in a welding of the image sheet to a member. A weld is a structural limitation that is not met by the pressure-sensitive adhesives used to stick the labels and protective coverings shown in Jones and Ambridge et al.

Regarding the reasoning based on Jones, it is respectfully submitted it suffers from errors that are substantially similar to those in the reasoning of the rejection based on Ambridge et al.

The patent describes a "protected label device" that provides a writing information surface difficult to alter, and that, among other things, makes written information relatively impervious to destruction by liquids and chemicals. See Col. 1, lines 13-29. The protected label

device comprises a label sheet 1, with a pressure sensitive adhesive backing 4 covering one side, and having indicia 17 on the opposite side. This label sheet is affixed to an object, and then a “transparent film protective layer” 2, with a “pressure sensitive transparent adhesive coating” 3 is laid over the label. The protective film layer 2 is larger than the label 1, so that it seals against the object to which the label is affixed. Therefore, it appears to have substantially the same structure as the label assembly of Ambridge et al.

The examiner contends, just as with Ambridge, et al., that there is an indentation in layer 2. However, applicant sees no evidence to suggest that a recess has been formed in its surface or that, if there is one, it has a depth that is the same as the thickness of the label 1. It appears merely to be draped over the label, with the film bending to conform to the shape of the label. As explained above, it is submitted that bending of the layer does not constitute an indentation under the common and ordinary meaning of that term, or as that term has been used in the specification of this application. Jones also does not meet or suggest the limitations requiring that image sheet be welded to the member, with the image side of the sheet facing away from the member.

It is respectfully submitted that the rejection based on Ambridge et al suffers from the same errors noted above in connection with claims 29-35. Please see those remarks.

Regarding the combination of U.S. Patent No. 4,857,129 of Jensen et al. with either Jones or Ambridge et al., applicants respectfully disagree that Jensen et al.’s teaching of basic uses of RF energy would make obvious the protected label systems of Jones and Ambridge et al. These label systems are designed for manual application of the label to an object. However, RF bonding or welding requires a source of RF energy and use of an electrode and steel platen. It is submitted that the teachings of Jensen et al. would discourage use of RF energy to create a bond to someone of ordinary skill in the art, as it would make the label systems of Jones and Ambridge unsuitable for the purposes for which they were designed. Therefore, the combination of Jensen et al. and either Jones or Ambridge et al. does not prove that a person of ordinary skill would find the claimed subject matter obvious.

Therefore, in view of these errors, it is submitted that the examiner has failed to establish a *prima facie* case of anticipation or obviousness. For at least this reason, applicants respectfully traverse the rejection of claims 37 and 38.

Amendments and New Claims

None of the amendments to the claims are intended to substantially narrow the scope of protection being sought, and are not being made in response to a rejection. They are being made to improve the language.

It is respectfully submitted that new claims 39-44 are allowable over the art of record for at least the same reasons as claim 37.

In view of the errors noted, Applicants have consequently elected not to address any errors in the reasoning for the rejections, or any other statements of the examiner, but reserve the right to do so at a later time. The failure to address any errors, or to address any particular statement of the examiner, does not constitute acquiescence to the statement or a waiver.

In conclusion, it is respectfully submitted that the application in condition to be allowed, and such action is respectfully requested.

Applicants hereby authorize the Commissioner to charge any fees due but not submitted with this paper to Deposit Account No. 07-0153. The Examiner is respectfully requested to call Applicant's Attorney for any reasons that would advance the current application to issue. Please reference Attorney Docket No. 125447-1005.

Respectfully submitted,  
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